

## Appeal Brief.

To initiate civil action against the "Board of Patent Appeals and Interferences" final rejection, made on 9-10-2001, for our invention "Computer Mouse".  
Application No. 08/653,425.

From:

David Muresan. address: 18204 30th Ave NE Seattle WA 98155 Ph (206) 367-0818

Today: is 10-01-2001

1. On 1-28-1996 we applied for a utility patent for our idea presented on page 1. The claim was: **"This computer mouse is characterized by using a magnet, to press the rubber magnetic core ball against the coordinates X and Y shafts"**.

2. On 2-27-97 the examiner Kim. J did a final rejection of our invention (page 2-6), being identical with Toyoda's invention presented on page 7 and 8, and having inside of mouse three contacts, the shafts 20X, 20Y and the bearing 52. It contains also the magnet 49 which keeps the ball from not falling when the pen is not in touch with the table. Our magnet is replacing their bearing 52. Toyoda did not present any intention to replace the bearing 52.

3. On 12-16-97 the examiner Kim. J did the second final rejection, as being similar with prior art because the above claim does not say that there are only two contacts inside of the mouse. I quote "Applicant states that the prior art does not teach the present invention which has just two contacts as it is seen in Figure 2, but it's not recited in the claim that there are only two contacts." (see page 9).

4. On 1-6-98 I sent a new specification with the following claim (page 10)

**A computer mouse having the (rotatable) rotating ball with two contacts inside of it, comprising: a magnet which attracts the mouse magnetic core ball and rubber outer layer, without touching the ball, against the coordinates x and y shafts, in a plane parallel with the shafts x and y plane."**  
We introduce the direction of the force because Toyoda's magnet exercises a force perpendicular on the 20X, 20Y and bearing 52 shafts plane.

5. On 2-05-98 the examiner Liang. R did not allow the new specification and claim to be entered, **because it introduces new matter** (see page 11).

6. On 5-8-98 corrected on 5-8-98 we appealed before the Board of Patents Appeals and Interferences (see page 12). The appeal was rejected on 7-16-2001.

7. On 7-21-2001 I filed for reexamination of the appeal. We have got the final rejection based on the fact that Toyoda's invention has a magnet like ours, so they are similar. The Judge Barry wrote: **"Because the claim uses the transitional term "comprising," however, it does not preclude additional contacts."**(see pages 13-17) First, the idea of this invention is to eliminate one contact to reduce the ball friction, and that is clear from the beginning to end. Second, the claim using the word "comprising" was not entered.

Inventers: David D Muresan & David Muresan



BEST AVAILABLE COPY

# COMPUTER MOUSE

This Invention refers to a Computer Mouse used to control the monitor screen. The existing Mouse use a mechanical schematic with a rubber ball which will rotate the X and Y coordinate shafts, as the Mouse is moved on a surface. The ball S is pressed against the X and Y shafts with a wheel H. (Fig1).

The disadvantages of the existing Mouse are: low precision of the Mouse Pointer on the screen, it will stuck often and it needs cleaning, especially the H wheel. The H wheel will create this problems because of the higher friction when it will move in a plane not perpendicular on it and the dirt on it. The ball will not rotate smoothly.

This invention eliminates the above disadvantages, because it will eliminate the wheel H, which is mostly responsible for them.

Bellow is describe this invention according with the figures 1 and 2, which represent:

Fig. 1. The mechanical schematic of a existing Mouse.

Fig. 2. The Mechanical schematic according with this invention.

In Fig. 2 the wheel is replaced with a magnet M, which will create the force F, necessary to press the ball S against the X and Y coordinate shafts.

Between the magnet and the ball will exist air and the ball has magnetic core. That will reduce the total ball friction, increase the precision and reduce the necessity of cleaning.

## CLAIM

This Computer Mouse is characterized by using a magnet, to press the rubber magnetic core ball against the coordinates X and Y shafts.

Bibliography: None

Authors: David Darian Muresan and David Muresan

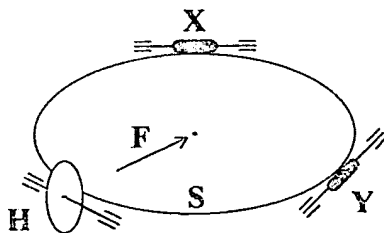


Fig. 1

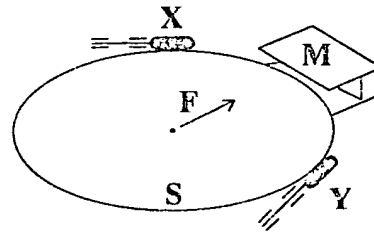


Fig. 2



UNITED STATES DEPARTMENT OF COMMERCE  
Patent and Trademark Office

Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/653,423	05/24/96	MURESAN	D

DAVID MURESAN  
18204 30TH AVE NE  
SEATTLE WA 98155

E6M1/0310

EXAMINER

KIM, J

ART UNIT

PAPER NUMBER

2609

DATE MAILED: 03/10/97

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Page 2

# Office Action Summary

Application No.

08/653,425

Applicant(s)

MURESAN ET AL

Examiner

Juliana Kim

Group Art Unit

2609

☒ Responsive to communication(s) filed on May 24, 1996

☐ This action is FINAL.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☒ Claim(s) 1 is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been  
☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☒ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Page 3

**Notice of References Cited**Application No.  
08/653,425

Applicant(s)

MURESAN ET AL

Examiner

Juliana Kim

Group Art Unit  
2609

Page 1 of 1

## U.S. PATENT DOCUMENTS

	DOCUMENT NO.	DATE	NAME	CLASS	SUBCLASS
A	5,371,516	12/94	Toyoda et al	345	163
B	5,583,541	12/96	Solhjell	345	163
C					
D					
E					
F					
G					
H					
I					
J					
K					
L					
M					

## FOREIGN PATENT DOCUMENTS

	DOCUMENT NO.	DATE	COUNTRY	NAME	CLASS	SUBCLASS
N						
O						
P						
Q						
R						
S						
T						

## NON-PATENT DOCUMENTS

	DOCUMENT (Including Author, Title, Source, and Pertinent Pages)	DATE
U		
V		
W		
X		

Page 4

Art Unit: 2609

## DETAILED ACTION

### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

2. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Toyoda et al.

Toyoda et al discloses an input device comprising a magnet (49) which attracts a rubber magnetic core ball (8) against the X and Y coordinate shafts (20X and 20Y). Note column 11, lines 13-20. Toyoda et al, however, does not mention that the input device is a mouse. But it would have been obvious to one of ordinary skill in the art to employ the feature of using magnet and magnetic core ball in a mouse because Toyoda et al admits that it is conventional for a mouse

Art Unit: 2609

to employ a rotatably supported ball (which can be the magnetic core ball as above). Note column 1, lines 19-22.


*Conclusion*

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Solhjell is made of record as disclosing a mouse operated by using magnetic field.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Juliana Kim whose telephone number is (703) 305-4962. The examiner can normally be reached on weekdays from 10:00 a.m. to 3:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Hjerpe, can be reached on (703) 305-4709. The fax phone number for this Group is (703) 308-6606.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-4700.



RICHARD HJERPE  
SUPERVISORY PATENT EXAMINER  
GROUP 2600

JK  
J. Kim  
February 27, 1997

various data such as of figures, letters, numerals, and other symbols into the computer accurately as desired.

A pen-type computer input device according to a ninth embodiment of the present invention will be described below with reference to FIGS. 17A, 17B, and 18.

As shown in FIGS. 17A and 17B, a magnet 49 is disposed in the support 7 inwardly of the ball 8. The ball 8 is magnetically attracted into contact with the conversion output shafts 20X, 20Y under magnetic forces from the magnet 49. When the ball 8 rotates, the rotation is transmitted to the conversion output shafts 20X, 20Y, which are then rotated. The ball 8 may comprise a core 50 in the form of a magnetic body such as a steel ball, and an elastic surface layer 51 of rubber or resin covering the core 50, as shown in FIG. 18, or may be made of a mixture of magnetic particles and rubber or resin. Therefore, the ball 8 is reliably held in contact with the conversion output shafts 20X, 20Y under magnetic forces from the magnet 49. The ball 8 is rotatably supported by a bearing 52, rather than holding ball. The other details of the pen-type computer input device shown in FIGS. 17A and 17B are identical to those of the pen-type computer input device according to the third embodiment shown in FIGS. 7A and 7B.

Because the ball 8 is magnetically attracted to the conversion output shafts 20X, 20Y, the rotation of the ball 8 can accurately be transmitted to the conversion output shafts 20X, 20Y. Accordingly, the direction in which the ball 8 rotates and the distance which is traversed by the ball 8 can accurately be detected.

In each of the above embodiments, any noise produced by the ball 8 as it rolls on the recording sheet is reduced.

Although certain preferred embodiments have been shown and described, it should be understood that many changes and modifications may be made therein without departing from the scope of the appended claims.

What is claimed is:

1. A pen-type computer input device comprising: a shank having a tip end; a ball rotatably supported on said tip end; a pair of rotatable members rotatable about X and Y axes extending perpendicularly to each other: means for pulling said ball upwards to maintain said rotatable members in rolling contact with said ball independent of pressure on said ball from sources external to said input device; and detecting means for detecting the direction in which said rotatable members rotate and the distance by which said rotatable members move.
2. A pen-type computer input device according to claim 1, further including a pair of fixed shafts fixedly mounted in said tip end of the shank, said rotatable members comprise ball bearing outer races rotatably mounted on said fixed shafts, respectively, said detecting means comprising electrically insulating and conductive regions attached to a side of each of said ball bearing outer races and circumferentially spaced at equal intervals, and electric circuit contacts held in sliding contact with said electrically insulating and conductive regions.
3. A pen-type computer input device according to claim 1, wherein said rotatable members comprise cylindrical bodies, said detecting means comprising a pattern of electrically conductive and insulating regions which are alternately formed circumferentially on each

of said cylindrical bodies, and two brushes held in alternate contact with said electrically conductive and insulating regions.

4. A pen-type computer input device according to claim 3, wherein said pattern of electrically conductive and insulating regions is disposed on each of said cylindrical bodies at one position thereon, said two brushes being displaced from each other in the circumferential direction of said cylindrical bodies.

5. A pen-type computer input device according to claim 1, wherein said rotatable members comprise cylindrical bodies, said detecting means comprising a pattern of light reflecting and absorbing regions which are alternately formed circumferentially on each of said cylindrical bodies, and optical means having a pair of optical members for each of said cylindrical bodies, each said optical member being arranged to apply light onto said pattern and receive reflected light from said pattern.

6. A pen-type computer input device according to claim 5, wherein said pattern of light reflecting and absorbing regions is disposed on each of said cylindrical bodies at two positions thereon, the patterns at the two positions being out of phase with each other, said optical means being associated with the patterns at the two positions.

7. A pen-type computer input device according to claim 1, further including a second ball held in rolling contact with said first-mentioned ball in rotation transmitting relationship to each other, one of said rotatable bodies being held in rolling contact with one of said balls, the other of said rotatable bodies being held in rolling contact with the other ball.

8. A pen-type computer input device according to claim 7, wherein said rotatable members comprise cylindrical bodies, said detecting means comprising a pattern of electrically conductive and insulating regions which are alternately formed circumferentially on each of said cylindrical bodies, and two brushes held in alternate contact with said electrically conductive and insulating regions.

9. A pen-type computer input device according to claim 8, wherein said pattern of electrically conductive and insulating regions is disposed on each of said cylindrical bodies at one position thereon, said two brushes being displaced from each other in the circumferential direction of said cylindrical bodies.

10. A pen-type computer input device according to claim 7, wherein said rotatable members comprise cylindrical bodies, said detecting means comprising a pattern of light reflecting and absorbing regions which are alternately formed circumferentially on each of said cylindrical bodies, and two optical fiber light detectors for alternately applying light and receiving reflected light from said light reflecting and absorbing regions.

11. A pen-type computer input device according to claim 10, wherein said pattern of light reflecting and absorbing regions is disposed on each of said cylindrical bodies at two positions thereon, the patterns at the two positions being out of phase with each other, said optical fiber light detectors being associated with the patterns at the two positions.

12. A pen-type computer input device according to claim 1, wherein said detecting means comprises a pair of fixed shafts fixedly mounted in said tip end of the shank, said fixed shafts being made of an electrically conductive material and having recesses and ridges formed on outer circumferential surfaces thereof at



FIG. 17A

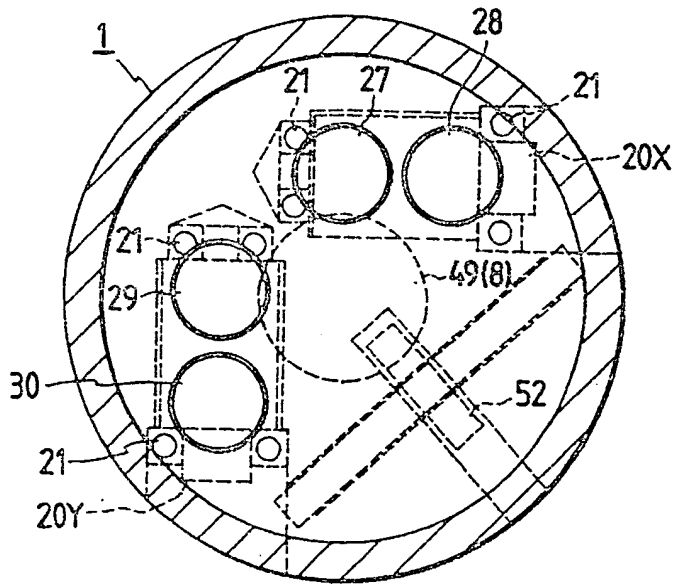


FIG. 17B

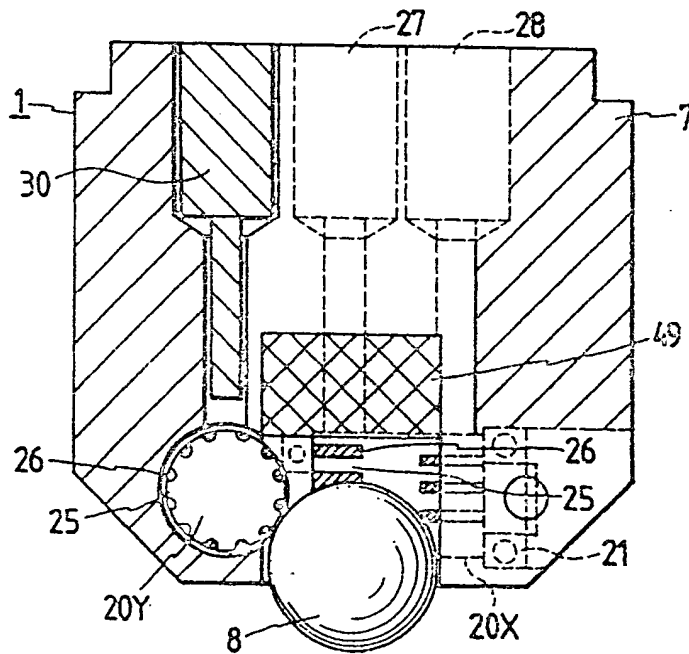
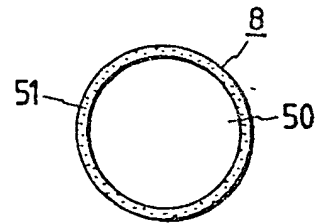


FIG. 18



Art Unit: 2774

to employ a rotatably supported ball (which can be the magnetic core ball as above). Note column 1, lines 19-22.

*Response to Arguments*

3. Applicant's arguments filed 6/2/97 have been fully considered but they are not persuasive. Applicant states that the prior art does not teach the present invention which has just two contacts as it is seen in Figure 2, but it's not recited in the claim that there are only two contacts.

*Conclusion*

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Solhjell is made of record as disclosing a mouse operated by using magnetic field.
5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for response to this final action is set to expire THREE MONTHS from the date of this action. In the event a first response is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event will the statutory period for response expire later than SIX MONTHS from the date of this final action.

6. Any response to this final action should be mailed to:

Box AF

## COMPUTER MOUSE

### Background of the invention.

#### 1. Field of the invention.

This invention refers to a computer mouse used to control the monitor screen.

#### 2. Prior Art Statement.

The existing Mouse use a mechanical schematic with a rubber ball which will rotate the x and y coordinate shafts, as the Mouse is moved on a surface T. The spherical ball S is pressed against the x and y shafts with a wheel H. (Fig1).

The disadvantages of the existing Mouse are: low precision of the mouse pointer on the screen, it will stuck often and the mouse needs cleaning, especially the wheel H. The wheel H will create these problems because of the higher friction with the ball, when it will move in a plane not perpendicular on it, and because it gets dirt from the surface T, on which the ball is moved. The ball S will not rotate smoothly.

#### Object and summary of the invention.

The object of this invention is to eliminates the disadvantages of the existing mouse. In order to do this, the wheel H is eliminated and the force necessary to press the ball against the coordinate shafts x and y are created by a magnet M, which will attracted the ball S, without to touch it. The force created by the magnet M is in a plane parallel with the plane of the shafts x and y. The ball S will rotate smoothly and the mouse pointer on the screen has higher precision.

#### Brief description of the drawings.

The description is related with the figures 1 and 2, which represent:

Fig. 1. The mechanical schematic of a existing mouse.

Fig. 2. The mechanical schematic according with this invention.

#### Description of the invention.

In Fig. 2 the wheel H is replaced with a magnet M, which will create the force F, necessary to press the ball S against the x and y coordinate shafts. The mouse case will create a inclosure for mouse so when the mouse is moved on the surface, the ball S will touch, inside of the mouse only the shafts x and y. The ball has magnetic core.

#### We claim:

A computer mouse having the rotatable ball with two contacts inside of it, comprising: a magnet which attracts the mouse magnetic core ball and rubber outer layer, without touching the ball, against the coordinates x and y shafts, in a plane parallel with the shafts x and y plane.

Bibliography: None

Authors: David Darian Muresan and David Muresan

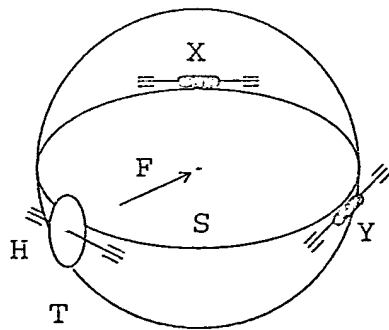


Fig. 1 (Prior Art)

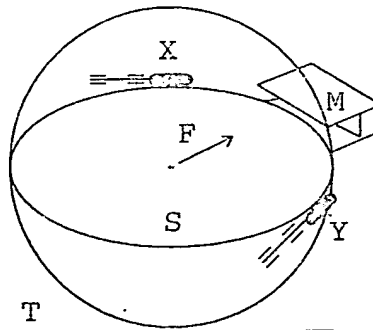


Fig. 2

# Advisory Action

Application No.

08/653,425

Applicant(s)

David Muresan

Examiner

Regina Liang

Group Art Unit

2774

## THE PERIOD FOR RESPONSE: [check only a) or b)]

- a) ☒ expires 3 months from the mailing date of the final rejection.
- b) ☐ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

- ☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jan 14, 1998 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

### ☒ The proposed amendment(s):

- ☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.
- ☒ will not be entered because:
- ☒ they raise new issues that would require further consideration and/or search. (See note below).
  - ☒ they raise the issue of new matter. (See note below).
  - ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
  - ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: As to amended claim, "A computer mouse having the rotatable ball with two contacts inside of it" raises new issue that would require further search, and "a magnet which attracts the mouse magnetic core ball ... in a plane parallel with the shafts X and Y plane" raises new issues that would require further search and the issue of new matter.

- ☐ Applicant's response has overcome the following rejection(s):

- ☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.
- ☐ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

- ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

- ☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

Claims objected to: none

Claims rejected: 1

- ☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

- ☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s).

- ☒ Other The new specification will not be entered since it contains new matter.

1-703-305-6712

Regina Liang  
REGINA LIANG  
PRIMARY EXAMINER  
ART UNIT 2774

# Appeal Brief

## for the invention "Computer Mouse"

**(1). Real party in interest.**

The inventors of this invention are: David Darian Muresan and David Muresan

**(2). Related Appeals and Interferences.**

We do not have any knowledge of any other appeals or Interferences.

This is our first appeal because the examiner did it final. The examiner opposed the inventions:

No. 5,371,516 (Toyoda) and No.5,583,541 (Solhjeli).

We do not have any representative. David Muresan, one of the authors, will represent us before the Patent Office.

**(3). Status of claims.**

The claim in our initial specification filed on (1-28-96) is :

**1. This Computer Mouse is characterized by using a magnet, to press the rubber magnetic core ball against the coordinates X and Y shafts.**

The claim in our substitute specification filed on (1-06-98) is :

**2. A computer mouse with two contacts inside of it, comprising:  
a magnet which attracts the mouse magnetic core ball and rubber outer layer, without touching the ball, against the coordinates x and y shafts, in a plane parallel with the shafts x and y plane.**

None of these claims has been canceled. Claim 2 is not entered.

The claim 1 is on appeal.

**(4). Status of amendments.**

After the final rejection, we sent a substitute specification in order to determine the examiner to withdraw the final, and also to comply with the rules how to fill a specification. Ex. the word "comprising" in the claim. This was not entered.

**(5). Summary of invention.**

In our initial specification, (sent 1-06-98) we present a mouse having the ball with 2 contacts, the coordinate shafts X and Y. The 3<sup>rd</sup> contact, which is a wheel H in Fig 1, present in all other mice ( in those opposed too) is replaced with a magnet in a proper position to create the same force, as direction and amplitude, as that wheel (3<sup>rd</sup> contact). The magnet does not touch the magnetic core ball. Fig 1. shows the mouse ball with 3 contacts and Fig 2. shows our mouse ball with 2 contacts.

**(6). Issues.**

The issue presented for review is: "Whether claim 1 is unpatentable under 35 U.S.C 103 over Toyoda"

**(7). Grouping of claims.**

Our invention contains only one claim.

**(8). Argument.**

In our invention the mouse ball has 2 contacts but in Toyoda's has 3 contacts. These contacts are inside of the mouse. The contact between the ball and the table, on which the mouse is moved is excluded in this comparison.

**(9). Appendix.**

The claim involved in appeal is:

**This Computer Mouse is characterized by using a magnet, to press the rubber magnetic core ball against the coordinates X and Y shafts.**

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

Paper No. 18

MAILED

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

SEP 10 2001  
PAT. & T.M. OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte DAVID D. MURESAN and DAVID MURESAN

Appeal No. 1998-3357  
Application No. 08/653,425

ON BRIEF

Before BARRETT, BARRY, and LEVY, Administrative Patent Judges.  
BARRY, Administrative Patent Judge.

DECISION ON REQUEST FOR REHEARING

This is a decision on the appellants' request, (Paper No. 17), that we reconsider our decision in Ex parte Muresan, No. 1998-3357 (Bd.Pat.App. & Int. July 16, 2001), which affirmed the rejection of claim 1 under 35 U.S.C. § 103(a) as being obvious over U.S. Patent No. 5,371,516 (Toyoda). Rather than reiterate their arguments in toto, we refer the reader to the request for the details thereof. After reconsidering our original decision in light of the arguments, we are not persuaded of error therein. Therefore, we deny the appellants' request to make any changes.

Appeal No. 1998-3357  
Application No. 08/653,425

At the outset, we emphasize that "the main purpose of the examination, to which every application is subjected, is to try to make sure that what each claim defines is patentable. ... [T]he name of the game is the claim ...." In re Hiniker Co., 150 F.3d 1362, 1369, 47 USPQ2d 1523, 1529 (Fed. Cir. 1998) (quoting Giles S. Rich, The Extent of the Protection and Interpretation of Claims--American Perspectives, 21 Int'l Rev. Indus. Prop. & Copyright L. 497, 499, 501 (1990)). With this principle in mind, we address the appellants' three arguments.

First, the appellants argue, "[m]y mouse with two contacts inside of the mouse and the table contact as the third, is different than Toyoda's Pen with three contact inside of the mouse (20x, 20y and wheel 52) and the table contact as the fourth contact." (Req. Reh'g at 1.) As we explained in our original decision, "[g]iving the claim its broadest reasonable interpretation, the limitations require a ball in contact with at least X- and Y-coordinate shafts. Because the claim uses the transitional term 'comprising,' however, it does not preclude additional contacts." Muresan, at 6.

Second, the appellants argue, "[m]y mouse has the case sliding on the table .... In my mouse the table contact and the x and y contacts will create a triangle to support the ball. In Toyoda's pen the contact 20x; 20y and the wheel 52 will create the necessary triangle to support the ball." (Req. Reh'g at 1.) As we noted in our original decision, "'limitations are not to be read into the claims from the specification.'" Muresan, at 5 (quoting In re Van Geuns, 988 F.2d 1181, 1184, 26 USPQ2d 1057, 1059 (Fed. Cir. 1993)).

Here, as we explained in our original decision, "claim 1 specifies [only] the following limitations: '[t]he Computer Mouse comprising: a magnet which attracts the rubber magnetic core ball against the X and Y coordinate shafts.'" Muresan, at 6. The claim recites neither "the case sliding on the table" nor that "the table contact and the x and y contacts will create a triangle to support the ball" as argued by the appellants. Accordingly, we are not persuaded by the argument.

Third, and last, the appellants argue, "[m]y invention has another advantage, which could not be found in any other mice, that is: possibility [sic] to place the contacts x and y in the



Appeal No. 1998-3357  
Application No. 08/653,425

middle plane of the ball, and so the friction is minimum." (Req. Reh'g at 1.) Claim 1, however, fails to recite "plac[ing] the contacts x and y in the middle plane of the ball ... so the friction is minimum" as argued by the appellants. Accordingly, we are not persuaded by the argument.

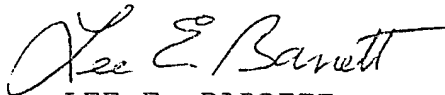
Any other arguments in the request for rehearing merely repeat those made in the appeal brief and duly considered by the Board in rendering its decision. Arguments not made in the brief are neither before us nor at issue but are considered waived.

We have granted the appellants' request to the extent that we have reconsidered our original decision, but we deny the request with respect to making any changes therein. .

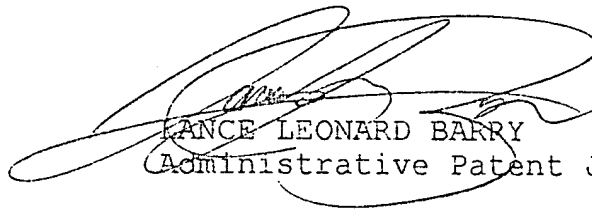
No period for taking subsequent action concerning this appeal may be extended under 37 C.F.R. § 1.136(a).

Appeal No. 1998-3357  
Application No. 08/653,425

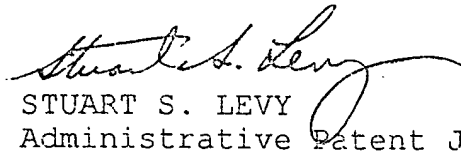
DENIED



LEE E. BARRETT  
Administrative Patent Judge



LANCE LEONARD BARRY  
Administrative Patent Judge



STUART S. LEVY  
Administrative Patent Judge

)  
)  
)  
)  
)  
) BOARD OF PATENT  
) APPEALS  
) AND  
) INTERFERENCES  
)  
)  
)  
)

LLB/gjh

**This Page is Inserted by IFW Indexing and Scanning  
Operations and is not part of the Official Record**

**BEST AVAILABLE IMAGES**

Defective images within this document are accurate representations of the original documents submitted by the applicant.

Defects in the images include but are not limited to the items checked:

- ☐ BLACK BORDERS
- ☐ IMAGE CUT OFF AT TOP, BOTTOM OR SIDES
- ☒ FADED TEXT OR DRAWING
- ☒ BLURRED OR ILLEGIBLE TEXT OR DRAWING
- ☐ SKEWED/SLANTED IMAGES
- ☐ COLOR OR BLACK AND WHITE PHOTOGRAPHS
- ☐ GRAY SCALE DOCUMENTS
- ☐ LINES OR MARKS ON ORIGINAL DOCUMENT
- ☐ REFERENCE(S) OR EXHIBIT(S) SUBMITTED ARE POOR QUALITY
- ☐ OTHER: \_\_\_\_\_

**IMAGES ARE BEST AVAILABLE COPY.**

**As rescanning these documents will not correct the image problems checked, please do not report these problems to the IFW Image Problem Mailbox.**